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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,794	01/19/2002	Dennis H. Harris	53002-1	4273

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EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,794

Applicant(s)

HARRIS ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 20, 2003 & August 11, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 7-12 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted May 20, 2003, and August 11, 2003 is acknowledged.

Newly added claims 11 and 12, drawn to a method of using the compositions claimed in invention group I, are withdrawn from consideration as they drawn to non-elected invention.

Claim Rejections 35 U.S.C. 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (6,444,647), in view of Albacarys et al. (6,338,855) Yokoyama et al. (6,419,962), Fuller (6,096,295) and Wenker (IDS).

3. Robinson et al. teaches a skin care composition comprising humectant, e.g., glycerin, exfoliant, glycerin, circulatory enhancement agent nicotinic acid, antibacterial agents, such as methyl paraben, anti-inflammatory agent, such as salicylic acid, antioxidant, such as vitamin E derivatives. See, the examples in columns 37-42 and the claims. The composition may also contain other well-known skin care ingredients including various dermatological acceptable carrier, surfactant, structural materials, polymers, and dermatological acceptable active ingredients, such as aloe, pantothenic acids, vitamins etc. See, columns 22-34.

Robinson et al. does not teach expressly the particular combination herein, or the employment of yohimbine, or sorbital, or particularly claim a plurality of two compositions.

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However, Fuller teaches that yohimbine is known to be useful for skin care composition. See, the abstract and the claims. Further, Albacarys et al., Yokoyama et al. and Wenker teaches that the particular ingredients employed herein are well-known dermatological acceptable ingredients. For examples, Wenker teaches Aloe vera gel is known to be useful in skin care composition. See the examples and the claims. Albacarys teaches that sage extract, methyl paraben, chamomile extract, are known active ingredients for skin care composition. See, particularly, column 18, line 7, column 19, lines 5-24, column 21, and lines 28-67. Yokoyama et al. teaches that extracts from natural products including sage extract, seaweed extract, are known to be useful in skin care products. See, particularly, column 5, lines 47-62. Further, sorbital, (sorbitan esters) is also a well known dermatological acceptable ingredients, See, column 7, line 66 bridging column 8, line 5.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a skin care composition comprising two phases and each phase comprising any of the well-known dermatological acceptable ingredients, such as aloe vera gel, yohimbine, pantothenic acid, nicotinic acid, and sorbital and glycerin, or combination thereof.

A person of ordinary skill in the art would have been motivated to make a skin care composition comprising two phases and each phase comprising any of the well-known dermatological acceptable ingredients, such as aloe vera gel, yohimbine, pantothenic acid, nicotinic acid, and sorbital and glycerin, or combination thereof, because each and every ingredients are known to be useful in skin care composition, and are known to be useful in combination with other ingredients. It is prima facie obvious to combine two or more

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ingredients, each of which is taught in the prior art to be useful for same purpose in order to form a composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art; thus, the claimed invention which is a combination of well-known dermatological acceptable ingredients, sets forth prima facie obvious subject matter, absent evidence to the contrary. See In re Kerkhoven, 205 USPQ 1069. The optimization of a result effective parameter, e.g., particle formula of the composition (two phases), is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. Note the intended function of each ingredient is not seen to further limit a claim drawn to a composition. As to the plurality of the formulation, put two slightly different compositions, which are known to be similarly useful for the same purpose, into one kit is seen to be obvious to one of ordinary skill in the art. Here, both the first phase and second phase comprises anti-inflammatory agent and circulatory enhancement agents. They would have been reasonably expected to be similarly useful, or be useful in combination.

4. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (6,444,647), in view of Albacarys et al. (6,338,855) Yokoyama et al. (6,419,962), Fuller (6,096,295) and Wenker (IDS) as discussed above, and in further view of International cosmetic ingredients Dictionary handbook.

5. The cited references do not teach expressly the employment of polyvinyl alcohol in the skin care composition.

6. However, as revealed in International cosmetic ingredients Dictionary handbook page 1097, polyvinyl alcohol is a well-known ingredient useful in skin care composition as film forming agent, thickener etc.

7. Therefore, it would have been prima facie obvious to employ a well-known skin care ingredient, such as polyvinyl alcohol, in a skin care composition.

Response to the Arguments

Applicants' amendments and remarks submitted May 20, 2003 have been fully considered. The amendments are persuasive with respect to the rejections under 35 U.S.C. 112 set forth in the prior office action. The claims as amended effectively read on a kit containing two compositions, which are obvious as discussed above.

8. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants argue that the cited references do not provide sufficient guidance or direction to arrive the claimed particular combination, stating that the cited references disclose thousands of dermatologically acceptable ingredients. The arguments have been carefully considered, but are not persuasive. Particularly, the specification, or the claims provide nothing but the suggested utility by the cited references, i.e., used as skin care composition. The specification, and/or the claims provide no evidences showing any (synergistic) benefit that solely reside on the claimed invention, and that would not be expected by the cited references. It is well settled that a selection from amongst equally suitable materials is obvious. Ex parte Winters 11 USPQ 2nd 1387 (at 1388).

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9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Examiner

Shengjun Wang
October 24, 2003

SHENGJUN WANG
PATENT EXAMINER